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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,346	03/12/2004	Kozo Nogi	Q80405	5598
23373	7590	02/15/2006	EXAMINER	
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			ZEMEL, IRINA SOPJIA	
			ART UNIT	PAPER NUMBER
			1711	

DATE MAILED: 02/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/798,346	Applicant(s) NOGI ET AL.	
	Examiner Irina S. Zemel	Art Unit 1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 6-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☒ Claim(s) 6-11 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 6/17/04 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/13/06; 6/17/04</u> | 6) <input checked="" type="checkbox"/> Other: <u>IDS 9/13/04</u> |

DETAILED ACTION

Claim Objections

Claims 6-11 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim can not depend on any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims 6-11 are not been further treated on the merits.

Applicants should note that upon amending the claims 6-11 to recite proper dependency, a restriction/election of species requirement may be issued based on recitation of different conditions and different apparatuses in dependent claims now withdrawn from consideration.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 recites "the treatment amount" which lack antecedent basis, but most importantly, it is not clear what this limitation means and what component is being referred to by the claimed numerical limitation.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5,672,633 to Brehm et al., (hereinafter "Brehm").

Brehm discloses a process for surface crosslinking treatment of a water-absorbing resin powder by adding a surface crosslinking agent to a water-absorbing resin powder and heat treating the mixture, wherein the water-absorbing resin powder after the heat treatment is stirred and cooled under an air flow. See illustrative example 1 in columns 7-8 disclosing surface treatment and air cooling in fluidized bed.

The invention as claimed, thus, is fully anticipated by the disclosure of the Brehm reference.

Claim Rejections - 35 USC § 102/103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 12 and 5 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over US Patent 5,672,633 to Brehm et al., (hereinafter "Brehm").

The disclosure of Brehm is discussed above. While Brehm does not expressly disclose that some of the particles and/or crosslinking agent are removed by the air flow (as per claim 2) or agglomeration of the particles (as per claims 5), the process

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disclosed in the Brehm reference is substantially identical to the claimed process, thus providing reasonable believe that at least some of the particles, and especially crosslinking agent in solution are inherently removed by drying in fluidized bed and at least some agglomeration of particles inherently occurs upon cooling and drying.

The burden is shifted to the applicants to provide evidence to the contrary.

Claim 5 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over either one of US Patent 5,397,626 to Berg et al., (hereinafter "Berg") or US patent 5,149,334 to Lahrman et al., (hereinafter "Lahrman").

Both patents discloses a process for surface crosslinking treatment of a water-absorbing resin powder by adding a surface crosslinking agent to a water-absorbing resin powder and heat treating the mixture, wherein the water-absorbing resin powder after the heat treatment is cooled. See, for example, illustrative embodiment 1 in column 51 of Lahrman and Berg.

The references do not expressly disclose agglomeration of the particles (as per claims 5), the process disclosed in the references is substantially identical to the claimed process,. Therefore, it is reasonably believed that agglomeration of at least some of the particles inherently occurs upon cooling and drying.

The burden is shifted to the applicants to provide evidence to the contrary.

Claim Rejections - 35 USC § 103

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brehm.

The disclosure of Brehm is discussed above. In the referenced example, Brehm discloses drying of about 90 kg/h of the crosslinked powder. However, it is well established by the case law that "mere scaling up of a prior art process capable of being scaled up, if such were the case, would not establish patentability in a claim to an old process so scaled." *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976) 531 F.2d at 1053, 189 USPQ at 148. Fluidizing bed dryers of capacity of well above 300 kg/h are well known in the art and, thus, scaling up of the process disclosed in Brehm is quite obvious and possible.

The burden is shifted to the applicants to provide evidence to the contrary.

Further, note that it is not clear what is referred to as "the treatment amount is 300 kg/h" in claim 3, and in example 1 the first step of treatment is conducted at the rate of 1000 kg/h.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brehm in combination with US patent 4,295,281 to Potter (hereinafter "Potter").

The disclosure of Brehm is discussed above, Brehm does not specifically address the conditions at which the fluidized bed cooling and drying operation is conducted, thus implying that any known fluidized bed drying operation conditions commonly known and used in the art are suitable for the invention disclosed by Brehm. It is notoriously known in the art that drying of powdery materials in fluidized bed can be conducted at reduced, normal or elevated pressures as evidence, for example, by Potter (columns 2-3). Therefore, utilizing reduced pressure operating conditions in

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fluidized bed drying step disclosed by Brehm would have been obvious with reasonable expectation of adequate results.

Information Disclosure Statement

Applicants should note that each patent listed in the IDS's that is not in the English language is ONLY considered to the extent of explanation of the relevance as provided by the applicants.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irina S. Zemel whose telephone number is (571)272-0577. The examiner can normally be reached on Monday-Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571)272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ISZ

Irina S. Zemel
Examiner
Art Unit 1711

